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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,481	09/09/2003	Igor V. Barsukov	0626-0004.04	2032
26568	7590	07/06/2005	EXAMINER	
COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD SUITE 2850 200 WEST ADAMS STREET CHICAGO, IL 60606			DOVE, TRACY MAE	
			ART UNIT	PAPER NUMBER
			1745	

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,481

Applicant(s)

BARSUKOV ET AL.

Examiner

Tracy Dove

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,22 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,22 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to the communication filed on 4/18/05. Applicant's arguments have been considered, but are not persuasive. Claims 2, 22 and 26 are pending and remain rejected in view of the prior art. This Action is made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 22 recites "the carbon particles including between 25% and 75% non-expanded graphite particles by weight and between 25% and 75% expanded graphite particles by weight", which is not supported by the specification as filed. The specification does not disclose the claimed weight percent ranges of claim 22 and does not even recite the term "non-expanded".

Regarding claim 26, the specification does not support the limitation "the carbon particles including between 25% and 75% non-expanded graphite particles by weight and between 25% and 75% expanded graphite particles by weight". The specification does not disclose the claimed weight percent ranges of claim 26 and does not even recite the term "non-expanded".

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Mercuri, US 5,985,452.

Note amended claim 2 is not entitled to the domestic priority date of provisional application 60/187,306.

Mercuri teaches a graphite mixture consisting of 0.18 pounds of unexpanded natural graphite flake blended with 1 pound of expanded natural graphite flake. The graphite mixture consists of about 85 wt% of expanded natural graphite flake and about 15wt% of unexpanded natural flake graphite. See Example III.

Thus the claims are anticipated.

Claims 2, 22 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al., US 6,451,486.

See claims 1, 5, 6, 10 and 16 of Davis. Thus, the claims are anticipated.

Response to Arguments

Applicant's arguments filed 4/18/05 have been fully considered but they are not persuasive.

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The objections to the specification have been withdrawn.

The new matter rejection of claim 1 (claim 4 has been incorporated into claim 1) has been withdrawn. Examiner appreciates Applicant pointing out the support for the limitation “the mixture comprises between 0.1 and 99.9 wt% expanded graphite”.

The new matter rejection of claim 22 and 26 is maintained. Applicant must have support for all endpoints of claimed ranges. Furthermore, Applicant’s statement that each of natural flake, natural vein, amorphous and synthetic graphite “is known by a person skilled in the art to be a ‘non-expanded’ graphite” is not accurate. Specifically, Mercuri 5,985,452 teaches a graphite mixture comprising expanded natural graphite and unexpanded, expandable particles of natural graphite (abstract). Thus natural graphite may be an “expanded graphite” or a “non-expanded graphite” material. Furthermore, one of skill in the art would have clearly known that synthetic graphite could be expanded or non-expanded graphite. For example, Davis 6,451,486 teaches “the expanded graphite particles and non-expanded graphite particles can be natural or synthetic” (2:8-9). Thus, Applicant’s argument that the specification teaches “between 25% and 75% non-expanded graphite particles by weight” is not persuasive.

Applicant states claim 2 has been amended to incorporate the limitation of claim 4, which renders the rejection of claim 2 moot. However, claim 4 was rejected under 35 U.S.C. 102(b) in view of Mercuri. See previous rejection of 11/3/04, page 5. Therefore, claim 2 remains rejected as being anticipated by Mercuri.

Applicant argues the declaration of Igor V. Barsukov establishes a date of invention by the Applicant for the subject matter of the rejection claims prior to the May 1, 2000 filing date of Davis et al. However, the declaration provides two exhibits that are not dated. Thus, Davis is

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not removed as a prior art reference against the claimed invention. Declarations cannot be used to add material to the specification to overcome a new matter rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is 571-272-1285. The examiner can normally be reached on Monday-Thursday (9:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TRACY DOVE
PRIMARY EXAMINER

June 30, 2005